

DETAILED ACTION

Application Status

1. Applicant's response to the Office Action mailed July 16, 2009 on January 19, 2010, is acknowledged. The Affidavit filed on January 19, 2010 has been received and considered.

Claim Disposition

2. Claims 1-13 and 17-20 are pending and are under examination.

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Maintained and Amended-Claim Rejections - 35 USC, 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claims 1-13 and 17-20 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed invention is directed to a method for preparing a protein- polymer conjugate or insulin-PEG conjugate (see claims 1 and 18). The claimed invention is directed to a genus of “amino reactive derivatives thereof”, metal chelators and organic solvent that are not adequately described. The specification fails to provide any additional representative species of the claimed genus to show that applicant was in possession of the claimed genus. A representative number of species means that the species which are adequately described are representative of the entire genus. The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, disclosure of drawings, or by disclosure of relevant identifying characteristics, for example, structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus.

The MPEP states that the purpose of the written description requirement is to ensure that the inventor had possession, as of the filing date of the application, of the specific subject matter later claimed by him. The courts have stated:

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"To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); In re Gostelli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966." *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

Further, for a broad generic claim, the specification must provide adequate written description to identify the genus of the claim. In *Regents of the University of California v. Eli Lilly & Co.* the court stated:

"A written description of an invention involving a chemical genus, like a description of a chemical species, 'requires a precise definition, such as by structure, formula, [or] chemical name,' of the claimed subject matter sufficient to distinguish it from other materials." *Fiers*, 984 F.2d at 1171, 25 USPQ2d 1601; *In re Smythe*, 480 F.2d 1376, 1383, 178 USPQ 279, 284985 (CCPA 1973) ("In other cases, particularly but not necessarily, chemical cases, where there is unpredictability in performance of certain species or subcombinations other than those specifically enumerated, one

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skilled in the art may be found not to have been placed in possession of a genus ...")

Regents" of the University of California v. Eli Lilly & Co., 43 USPQ2d 1398.

The MPEP further states that if a biomolecule is described only by a functional characteristic, without any disclosed correlation between function and structure of the sequence, it is "not sufficient characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence." MPEP § 2163. The MPEP does state that for a generic claim the genus can be adequately described if the disclosure presents a sufficient number of representative species that encompass the genus. MPEP § 2163. If the genus has a substantial variance, the disclosure must describe a sufficient variety of species to reflect the variation within that genus. See MPEP § 2163. Although the MPEP does not define what constitute a sufficient number of representative species, the courts have indicated what do not constitute a representative number of species to adequately describe a broad generic. In *Gostelli*, the courts determined that the disclosure of two chemical compounds within a subgenus did not describe that subgenus. *In re Gostelli*, 872, F.2d at 1012, 10 USPQ2d at 1618. The MPEP lists factors that can be used to determine if sufficient evidence of possession has been furnished in the disclosure of the Application. These include "level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention. Disclosure of any combination of such identifying characteristics that distinguish the claimed invention from other materials and would lead one of skill in the

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art to the conclusion that the applicant was in possession of the claimed species is sufficient." MPEP § 2163. While all of the factors have been considered, a sufficient amount for *a prima facie* case is discussed below.

Further, to provide evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include: a) the scope of the invention; b) actual reduction to practice; c) disclosure of drawings or structural chemical formulas; d) relevant identifying characteristics including complete structure, partial structure, physical and/or chemical properties, and structure/function correlation; e) method of making the claimed compounds; f) level of skill and knowledge in the art; and g) predictability in the art.

Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus. Moreover, *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir.1991), states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in *possession of the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*" (See page 1117). The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed" (See *Vas-Cath* at page 1116). The skilled artisan cannot envision the detailed chemical structure of the encompassed genus of polypeptides, and therefore, conception is not achieved until reduction to practice has occurred,

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regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993).

Therefore, for all these reasons the specification lacks adequate written description, and one of skill in the art cannot reasonably conclude that the applicant had possession of the claimed invention at the time the instant application was filed.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claim 3 remain rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter, which applicant (s) regard as their invention.

Claim 3 is indefinite because the claim represents and improper Markush claim.

Maintained-Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

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except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-11 remain rejected under 35 U.S.C. 102(e) as being anticipated by Lewis et al. (US Patent No. 6,706,289, October 31, 2001).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Lewis et al. teach a preparation of polyethylene glycol conjugated to human insulin (see paragraph 43). The polymer taught by Lewis et al. is hydrophilic (see paragraph 1). Paragraph 30 of the patent discloses that the polymer is dissolved in an organic solvent. At paragraph 12 of the patent the use of DMSO is disclosed in a concentration as disclosed by the instant application. Lewis et al. teaches a pH within the 5-7 range recited in the claims (see paragraphs 9 and 27). In addition, a temperature within the recited range is disclosed at paragraph 27 of the patent. Therefore, the limitations of the claims are met by the reference.

Response to Arguments

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6. Applicant's arguments have been considered in full. Rejections/Objections withdrawn will not be discussed herein as applicant's comments are moot. Note that the rejections of record under 35 USC 112, first and second paragraphs; and 102(e) remain for the reasons above and stated herein. The amendments of record have been amended for clarification, thus this communication is made non-final.

Regarding the rejection under 35 USC 112, second paragraph over claim 3, the amendment filed did not address this rejection. No claim amendments were made and applicants did not have any remarks pertaining to the rejection of this claim. Thus as the issue remains the rejection is maintained.

Note that the rejection under 35 USC 112, first paragraph remains. Applicant's amended claims 1 and 18 which reduced some of the issues. However, the claims still broadly read on any amino reactive derivative, any metal chelator and any organic solvent. Applicant points to the listing of specific ones, however, independent claims 1 and 18 are not limited to any specific one. The claims broadly read on any metal chelator for example. It is noted that claim 3 for example lists the amino derivative as pointed to by applicants, however, claim 1 has to stand on its own and is not so limited.

The Affidavit provided pertaining to the rejection under 35 USC 102(e) has been considered in full but was not deemed persuasive. The Affidavit states that "To the extent that US Patent No. 6,706,289 discloses the subject matter of claims in the present application, such disclosure was derived from the undersigned inventor (Paul Schmidt), rather than having been invented by the inventive entity of Danny Lewis, Paul

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Schmidt and Kenneth Hinds that is named in US Patent No. 6,706,289". Firstly, the cited patent US Patent No. 6,706,289 (Lewis, Hinds and Schmidt) has a different inventive entity than the instant case with inventors Hinds, Lewis, Schmidt and Campell. Further, the Affidavit mentions that "subject matter of claims in the present application, such disclosure was derived from the undersigned inventor, rather than having been invented by the inventive entity of Danny Lewis, Paul Schmidt and Kenneth Hinds that is named in US Patent No. 6,706,289", however, there was no indication of what materials they did not invent (indicated by claim numbers) or any petition to remove any inventors. Thus, the rejection remains as the arguments presented were not deemed to be persuasive.

Conclusion

7. No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope A. Robinson whose telephone number is 571-272-0957. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hope A. Robinson/

Primary Examiner, Art Unit 1652